

27. (New) Backing material for medical purposes according to claim 15, characterized in that the adhesive composition is applied to the backing material with a weight per unit area of between 90 g/m<sup>2</sup> and 500 g/m<sup>2</sup>.

28. (New) Backing material for medical purposes according to claim 27, characterized in that the adhesive composition is applied to the backing material with a weight per unit area of between 130 g/m<sup>2</sup> and 500 g/m<sup>2</sup>.

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**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

**ADDITIONAL FEES**

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

**REMARKS**

Claims 17-20 stand objected to as being in improper form. The claims have been amended, rendering the objections moot. These claims are now in condition for treatment on the merits.

Claims 1-16 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> ¶, for being indefinite for several reasons, as follows:

- Claim 1 was amended by adding commas to more clearly specify that the tensile strength limitation relates to the backing, and not the yarns *per se*.

Examiner's comments on the bottom of page 2 to the top of page 3 indicated that this point required clarification.

- Claim 1, 2 and claims dependent upon them are rejected for not reciting specific structures or compositions, but instead recite only physical characteristics. In support the Examiner cites *Ex parte Slob*. This rejection is traversed below.
- Claim 1 was rejected due to the alleged confusing use of a "means" term. This has been addressed by amendment.
- Claims 1 and 2 were rejected for not disclosing fully, the term "doped adhesive." A doped adhesive is an adhesive is one that comprises an active substance. This term is clear to those with ordinary skill in the art.
- Claims 3, 5, 8, 10 and 15 were deemed indefinite because they recite a broad range, followed by a narrower range. In response, the Applicants have amended claims 3, 5, 8, 10 and 15, and added new dependent claims 21-28 that recite the desired ranges.
- Claim 8 lacks sufficient antecedent basis for "releasable active substance or substances." Claim 8 is now amended to recite "a releasable..." so as to preclude the need for an antecedent. Support for the limitation is found on pages 15-16 of the specification.

Claims 1, 2, 4, 7, 9, 10 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4, 967, 740 to Riedel ("Reidel").

Claims 1-10, 12, 13 15, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ganschow in view of Merkle; claim 11 further in view of Bredahl; and claim 14 further in view of Crawley.

### **Ex Parte Slob Does not Render the Claims Indefinite**

The Applicants respectfully suggest that *Slob* is not applicable to this matter. First, *Slob* is not even listed in the MPEP table of cases, which indicates that it is no longer proper authority. This conclusion finds support in the issuance of claim 1 of the cited references, Ganschow or Riedel. These cited claims would also theoretically fall under *Slob* due to their lack of compositional and structural limitations, yet they were allowed and issued.

However, even if *Slob* were still authoritative, Applicants do not believe that it properly applies to their claims. The facts of *Slob* are so dissimilar to the instant claims that it cannot have any bearing on this matter.

The claim limitation at issue in *Slob* was “a liquefiable substance having a liquefaction temperature from about 40°C to 300°C and being compatible with the ingredients in the powdered detergent composition.” This was held too broad because it purported “to cover everything which will perform the function regardless of its composition.” *Ex parte Slob*, 157 USPQ, 172,173 (Patent Office Board of Appeals 1977) (Emphasis added). The court further stated that it is improper to claim compounds based on “what it is desired that they do rather than what they are.” *Slob* at 173.

In *Slob*, one with skill in the detergent art would not likely appreciate the scope of substances that satisfy “a liquefiable substance having a liquefaction temperature from about 40°C to 300°C and being compatible with the ingredients in the powdered detergent composition.” In comparison to the specific terminology relating to specific and known elements in the present claims, the facts of *Slob* are clearly distinguishable.

Applicants’ claims are directed to backing materials comprising nonwoven fabric having strength of at least 10N/cm, and is at least partially covered with an adhesive. One with skill in the medical materials art would clearly understand what backings and nonwovens are, and how, as backing materials they are combined with adhesives.

In addition, the Examiner's attention is drawn to claim 1 of either of the Examiner's cited references, Ganschow or Riedel. The claims therein recite compositions even more broad than Applicants' because in addition to omitting compositional or structural requirements, they also omit any recitation of a physical property. Yet, these claims were allowed and issued. Examiner's application of *Slob* to the present application would seem to suggest that further broadening of Applicants' claims 1 and 2 by removing the tensile strength measure would render the even broader claim patentable. This, of course, is illogical.

Applicants respectfully suggest that the rule of *Slob* does not constitute controlling law in view of it not being cited in the MPEP case index. But, assuming *arguendo* that it was still valid authority, the claims herein do not fit under the rule of *Slob*. Accordingly, it is respectfully requested that this basis of rejection be withdrawn.

#### **Reidel Does not Anticipate the Claimed Subject Matter**

Reidel cannot anticipate the claims because it does not teach each claim limitation. Claims 1 and 2 recite that the backing material is not simply a nonwoven, but a nonwoven overstitched by yarns and therefore, reinforces the strength of the backing. This is not disclosed in Reidel.

Further, Reidel does not disclose the inclusion of a doped adhesive.

On this basis alone, the Applicants suggest that the rejection under § 102(b) is improper.

The Examiner apparently maintains this rejection largely on the basis that Applicants' backing recites properties that are inherent to the material disclosed by Reidel. See, Office Action, page 5, ¶11, lines 7-10. This approach is also used in asserting the rejections under § 103(a). Applicants respectfully suggest that the Examiner's application of inherency doctrine is improper and does not satisfy his burden of proof of unpatentability.

It is not sufficient to establish inherency by merely stating that a certain characteristic may be present in the prior art. MPEP § 2112, *citing In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). To establish inherency, “the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (Emphasis added). Examiner has not satisfied this standard, because his statements constitutes mere conclusory allegations as to the inherency of the prior art inventions.

For example simply stating that the tensile strength values recited by Applicants “would be inherent to the material disclosed by Riedel” because all stitch-bonded polyesters are similar falls far short of the PTO’s standards, as discussed above. *See* MPEP § 2112. The Examiner’s similar assertions of inherency in the other claims are also improper, and the rejections under § 102(b) should be withdrawn solely on this basis.

However, Applicants also demonstrate that by comparing Reidel’s data with Applicants’ that the backings are indeed distinct. The force required to cause the respective materials to fail are given in claim 1, and in Reidel’s Tables I and II. Applicants’ claim a minimum ultimate tensile strength of at least 10, which is supported in Examples 1 and 2. Reidel’s values never reach even 5. *See e.g.*, Table 2, column N.

Applicants note that the data are expressed in different units, *perhaps* reflecting the application of different standardized strength tests. However, the values presented are at least consistent with Reidel’s materials not inherently having Applicants’ claimed values. The Examiner has not met his burden to prove that such values are inherently equivalent.

In support of the proposition that these properties are not identical, other physical parameters support the conclusion that the backings are not inherently identical. For example, Applicants’ stress elongation is 28%. This is the percent increase in length

achieved at the point of the material's failure; i.e., rupture or tearing. Reidel's minimum value is about 120%. Applicants respectfully suggest that strength and yield modulus, etc., are not inherent as suggested by the Examiner. Accordingly, Reidel does not teach the same material and an anticipation rejection is improper. Withdrawal of the rejection is respectfully requested.

The same line of reasoning applies to claim 2, and dependent claims 4, 7, 9, 10 and 16 as well. Applicants request withdrawal of all of the rejections of the aforementioned claims under § 102(b).

**Neither of the Cited References Alone or in Combination Render the Claims Obvious**

Claims 1-10, 12, 13, 15, and 16 were rejected under § 103(a) over Ganschow in view of Merkle. The Examiner asserts inherency to impart Applicants' physical property values to the reference's in the exact manner used in maintaining the rejection under § 102(b). It is clear that although inherency doctrine applies to obviousness rejections, the Examiner again has not properly done so.

In determining whether the invention **as a whole** would have been obvious under 35 U.S.C. 103, Applicants must first delineate the invention as a whole. In delineating the invention as a whole, look not only to the subject matter which is literally recited in the claim in question... **but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification.**

MPEP § 2141.01

The Examiner has not considered the claimed subject matter or the references in their entirety as required. For example, the terms "tensile strength," "stress elongation," or "hot-melt" do not even appear in Granschow. There can be no reasonable basis for using Granschow as extrinsic evidence of the inherency of the Applicants' material's physical properties.

Ganschow's invention is directed to a more easily unrollable tape. Accordingly, a foam/release layer is a required addition. Col. 1, lines 5-8. Applicants' examples do not include any release component. Given the entirety of the Applicants' and Ganschow's teachings it is clear that one with ordinary skill could not use Ganschow to arrive at the Applicants' invention.

Merkle is directed only to the adhesive component. Merkle teaches the use of a three block polymer. See Abstract, and col. 5, lines 9-10. Applicants use a multiblock polymer achieved by mixing a triple block with a double block. See specification, Example 1. The teachings therein cannot cure the deficiencies in Ganschow.

In sum, Ganschow and Merkle do not teach all of Applicants' claim limitations. Neither could one with skill in the art come close to approximating the claimed subject matter by relying on these teachings. Accordingly, withdrawal of the rejections of claims 1-10, 12, 13, 15, and 16 under § 103(a) are respectfully requested.

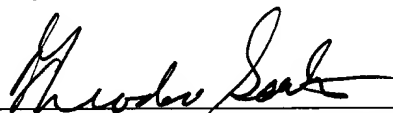
Applicants request withdrawal of the rejection under § 103(a) over Bredahl in view of Ganschow and Merkle. It is believed that the foregoing discussion of the principal references renders this rejection moot.

Applicants request withdrawal of the rejection under § 103(a) over Crawley et al., in view of Ganschow and Merkle. It is believed that the foregoing discussion of the principal references renders this rejection moot.

### CONCLUSION

Applicants believe that all of the Examiner's objections and rejections have been directly addressed. Reconsideration and withdrawal of the rejections is requested in view of all amendments and remarks herein.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Theodore Gottlieb', is written over a horizontal line.

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### SEPARATE SHEET OF MARKED UP CLAIMS

1. (Amended twice) Backing material for medical purposes, characterized in that the backing material is a nonwoven, overstitched by ~~means of yarns,~~ and having an ultimate tensile stress strength of at least 10 N/cm and in that the backing material is coated partially or over its full area on at least one side with a doped adhesive composition.
3. (Amended twice) Backing material for medical purposes according to Claim 1, characterized in that the number of stitches on the web, ~~in particular longitudinal stitches,~~ is comprises at least 3/cm, ~~preferably from 5 to 50/cm.~~
5. (Amended twice) Backing material for medical purposes according to Claim 1, characterized in that the backing material has a basis weight of up to 500 g/m<sup>2</sup>, ~~preferably from 10 to 350 g/m<sup>2</sup>.~~
8. (Amended twice) Backing material for medical purposes according to claim 1, characterized in that the adhesive composition comprises a ~~the~~ releasable active substance or substances in an amount of from 0.01 to 60%, ~~by weight, preferably from 0.1 to 20% by weight.~~
10. (Amended twice) Backing material for medical purposes according to at least one of the preceding claims, characterized in that the adhesive composition has a dynamic-complex glass transition temperature at a frequency of 0.1 rad/s of less than 15°C, ~~preferably from 3°C to -30°C, with very particular preference from -3°C to -25°C.~~
15. (Amended twice ) Backing material for medical purposes according to at least one of the preceding claims, characterized in that the adhesive composition is applied to the backing material with a weight per unit area of greater than 15 g/m<sup>2</sup>, ~~preferably between 90 g/m<sup>2</sup> and 500 g/m<sup>2</sup>, with very particular preference between 130 g/m<sup>2</sup> and 500 g/m<sup>2</sup>.~~

17. (Amended) Backing material for medical purposes according to ~~one or more of the preceding claims~~ claim 1, characterized in that on the side opposite that coated with the self-adhesive composition, the backing material is finished with a water-repellent layer, impregnation, release layer and/or coating.

18. (Amended) Backing material for medical purposes according to ~~one or more of the preceding claims~~ claim 1, characterized in that at least one additional layer comprising sheets, foams or nonwovens is applied on the backing material.

19. (Amended) Backing material for medical purposes according to ~~one or more of the preceding claims~~ claim 1, characterized in that the backing material is coated with metallic substances by vapour deposition.

20. (Amended) Backing material for medical purposes according to ~~one or more of the preceding claims~~ claim 1, characterized in that the coated backing material is covered after application of the self-adhesive composition or is provided with a wound pad or with padding.